

Appl. No. 10/714,281
Amdt. dated December 21, 2009
Reply to Office Action of September 21, 2009

Remarks

The present amendment replies to the Official Action mailed September 21, 2009. Claims 5-18 and 20-24 were rejected under 35 U.S.C. 101 as directed to non-statutory subject matter. Claims 5-24 were rejected under 35 U.S.C. 103(a) over Flagg U.S. Patent No. 6,456,979 in view of Libman U.S. Patent No. 6,999,938 (Libman) in further view of Debber U.S. Patent Publication No. 2003/0144887 (Debber). Claims 5, 11, 12 and 14 have been amended to be more clear and distinct. Claims 5-24 are presently pending.

Section 101 Rejection

The Section 101 rejection of claims 5-18 and 20-24 has been addressed by amending claim 5 to recite that the system is "computer implemented", that "long term storage" hosts the "risk data repository" and the "insurance data repository", and that the "risk evaluator is implemented as a software module hosted by the computer and executed under control of a processor" so patent eligible statutory matter is clearly recited. With respect to claim 14, the method steps now positively recite machine elements tied to accomplishing those steps. Claim 19 was not previously rejected on these grounds.

In light of the present amendments, the Section 101 rejections should be reconsidered and withdrawn.

Art Rejections

All of the art rejections are based upon Flagg in view of Debber in further view of Libman. Applicants traverse the Official Action's analysis of these items. Flagg, Debber and Libman do not support the rejections based thereon. Any reliance upon Official Notice is

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traversed as addressed in greater detail below. The rejections should be withdrawn and the claims as presently amended should be promptly passed to issue as addressed in further detail below.

Flagg is entitled "Method of Evaluating a Permanent Life Insurance Policy". In this context, his Abstract addresses a "matrix of mortality profiling" which "may include gender-based, lifestyle and pricing method risk values". More specifically, Flagg addresses a method for "evaluating permanent life insurance policies for cost and performance criteria." Flagg, col. 1, lines 7 and 8. It does not appear to address "mortgage insurance" or "packages including a combination of a mortgage insurance component and at least one additional insurance component having an effect on the risk of the mortgage insurance component when sold together with the mortgage insurance component" as claimed by claim 1. At page 4, the Official Action appears to admit as much stating: "Flagg and Debber do not disclose the insurance data repository including information about a mortgage insurance component and additional insurance components" relying on Libman at Fig. 9, col. 14, lines 23-27.

Consequently, the Official Action effectively admits Flagg fails to teach any elements of claim 5 as "the risk information" in the "risk data repository" is "used in determining the risk and cost of providing insurance packages" where those packages include a combination of components admittedly absent from Flagg and Debber. Similarly, the "insurance data repository" of claim 5 includes "information about the mortgage insurance component and the one or more additional components". Flagg is again silent as it only appears to address permanent life

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insurance. The "risk evaluator" of claim 5 adjusts "the cost of the mortgage insurance component in light of the effect on said risk of the at least one additional component". Flagg is again silent.

Debber par. [0073] is cited as describing "a system comprising a risk data repository and a risk evaluator". However, the only mention of "risk" in par. [0074] of Debber is his recitation of "risk query module 408" and "risk database interface module 410". By contrast, claim 5 recites "a risk evaluator for determining risks and costs associated with providing insurance, the risk evaluator being operative to compute overall risk and cost for the combined package and adjust parameters of the package components including adjusting the cost of the mortgage insurance component in light of the effect on said risk of the at least one additional insurance component to optimize the risk and cost of the package." The recitation found in Debber par. [0074] clearly does not teach and does not make obvious the "risk evaluator" claimed by claim 5. A review of the remainder of Debber establishes that while paras. [0041], [0063], [0072-0079], [0091] and [0094] address aspects of his treatment of risk information, their teaching is very general such as retrieve "risk data corresponding to the application data". Consequently, Debber as a whole does not teach and does not make obvious the claimed "risk evaluator".

Debber is entitled "System and Method for Electronically Creating, Filing and Approving Applications for Insurance Coverage". The Debber approach focuses on generating "one or more applications and automatically "submitting" them to respective insurer systems". Debber, Abstract. As such it mainly focuses on electronically creating, filing and approving insurance applications. As correctly admitted by the Official Action, Debber has no specific teaching relating to packages of insurance comprising two or more components including a mortgage

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insurance component, or the importance of the evaluation of the effect upon the mortgage insurance component made by an additional component, such as the job loss component or insurance of dependent claims 10-13, independent claim 14 and its dependent claims 15-18, independent claim 19, and new dependent claims 20-24.

In analyzing claim 5, the Official Action states "Libman does disclose 'the insurance data repository including information about a mortgage insurance component and additional insurance components' " citing Libman Fig. 9 and col. 14, lines 23-27 further stating it "would have been obvious" to "combine the teachings of Flagg, Debber and Libman to include data about mortgage insurance in order to market bundled products to consumers with more than one type of insurance need." With respect to claim 10, the Official Action states "A predictable result of Debber and Libman would be to provide as many types of insurance packages as possible to clients in order to offer them better, more customized products to meet their needs at competitive prices (KSR International Co. v. Telefax Inc., 82 USPQ 2d 1385 (US 2007))."

This conclusory analysis is traversed as legally incorrect and factually unsupported. The key to supporting any prima facie conclusion of obviousness under 35 U.S.C. 103 is the clear articulation of the reason or reasons why the claimed invention would be obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be implicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements". In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006) (quoted with approval by KSR).

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Libman provides no basis for modifying Flagg and Debber to rectify their admitted failings as a reference. Libman addresses an "Automated Reply Generator Direct Marketing System" for "automatically preparing customized replies in response to a plurality of clients". Libman, Title and Abstract. As such, it is primarily focused on mass mailings, emailings or other potential contacts with possible customers and the handling of replies therefrom. In this context, at col. 6, lines 56-65, Libman states "Financial Product" as the term is used herein is used in its broad sense to include any financially-related product, service or plan. The term would include, for example, insurance products and services, banking products and services, securities and investment products and services, and the like. Examples of insurance products would include individual life insurance of all types, tax deferred annuities of all types, health insurance of all types, disability insurance of all types, annuities or other payment vehicles." The text at col. 14, lines 15-30 is similarly broad brush and says specifically at lines 24-27 "Where combinations of insurance products are included, they may include, for example, a combination of an individual term life insurance product and an individual permanent life insurance product." No other examples of combined insurance offerings are given, and there is no specific teaching of mortgage insurance in combination with any other insurance, and in particular, there is no teaching of job loss insurance.

Thus, even if a combination of individual term life insurance and individual permanent life insurance is somehow imported from Libman to Debber, such a package does not make the present claims obvious. In this regard, it is noted that claim 1 as amended recites "a risk evaluator . . . to . . . adjust parameters of the package components including adjusting the cost of

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the mortgage insurance component in light of the effect on said risk of the at least one additional component", and the remaining independent claims address optimizing the package in a manner not addressed by Debber and Libman individually, and not obvious from the two items taken in combination.

The present invention as claimed by claims 5, 14 and 19 addresses "insurance packages including a combination of a mortgage insurance component having a risk when sold separately and at least one additional component having an effect on the risk of the mortgage insurance when sold together with the mortgage insurance component" (claim 5) and "combined packages including mortgage insurance and job loss insurance" (claims 14 and 19). Dependent claim 10 specifically recites "job loss insurance". While applicants do not acquiesce in the Examiner's apparent suggestion that it is obvious to package as many different kinds of insurance as needed by a particular customer, that is **NOT** what is claimed here. The present inventors have recognized that certain types of insurance, like job loss insurance, have an effect on the risk of mortgage insurance making a package including both components potentially mutually beneficial. It is clear that other types of insurance such as auto insurance, worker's compensation insurance for a business, an umbrella policy, burial insurance, travel insurance and many other types of insurance available today don't effect risk in a way which would allow one to adjust the cost of the mortgage insurance accordingly. In times, such as the present ones, it is clear the present invention is a worthwhile idea and it is not suggested and is not made obvious by the relied upon art.

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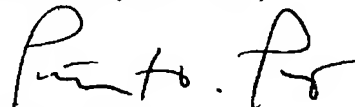
Official Notice

Any reliance upon Official Notice is contrary to the art of record, is not supported thereby and is hereby specifically traversed. The Examiner is requested to withdraw such reliance or to provide a citation of art to support any facts relied upon. Pursuant to MPEP § 2144.03, it is not "appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." This Section further establishes "It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." In light of the admitted and demonstrated failings of the items relied upon, any attempted reliance upon Official Notice is inappropriate.

Conclusion

All of the presently pending claims, as amended, appearing to define over the applied references, withdrawal of the present rejection and prompt allowance are requested.

Respectfully submitted,



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